5244-0051-2X DIV

#19
6-11-99

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :

TETSURO MOTOYAMA : GROUP ART UNIT: 2756

SERIAL NO: 08/738,659 :

FILED: OCTOBER 30, 1996 : EXAMINER: LUU

FOR: METHOD AND SYSTEM FOR DIAGNOSIS AND CONTROL OF MACHINES USING CONNECTION AND CONNECTIONLESS MODES OF COMMUNICATION

REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

This Reply Brief is responsive to the Examiner's Answer mailed April 6, 1999.

I. The Examiner's Answer does not Address the Deficiencies of the Rejection Raised in the Appeal Brief

In the Examiner's Answer, the Examiner has maintained the same basic reasons for finding the presently claimed invention unpatentable as were set forth in previous Official Actions. When the Appeal Brief was prepared, the Applicant was aware of the reasons why the Examiner believed that the pending claims were unpatentable. Thus, a number of arguments were presented in the Applicant's Appeal Brief which specifically explained why the outstanding rejection should not be maintained.

Despite the presentation of the specific arguments explaining the deficiencies of the rejection, the Examiner's Answer provides no specific replies to the deficiencies which have been raised, besides a boiler plate response that there is no requirement for the features of one

reference to be "bodily incorporated into the other reference." See p. 9 of the Examiner's Answer.

Due to these specific deficiencies which were previously identified and not have been addressed by the Examiner, each of the pending claims should be allowed. The specific deficiencies which have already been set forth in the Appeal Brief will not be reviewed again in detail. However, a brief overview of the reasons which have not been addressed by the Examiner is in order.

1. Kraslavsky et al is directed towards a high speed system.

As explained at the top portion of page 6 of the Appeal Brief, Kraslavsky et al is directed to a high speed system for transmitting real-time or near-real-time status information. Modifying Kraslavsky et al to operate using Internet electronic mail which may be quite slow would be contrary to the teachings of Kraslavsky et al.

2. E-mail is for transmission between human users.

As explained in pages 7 and 8 of the Appeal Brief, electronic mail has historically been for the transmission of text messages among computer users. Therefore, one of ordinary skill in the art at the time the invention was made would not utilize e-mail to transmit the type of information which is exchanged in Kraslavsky et al.

3. The prior art already provides a standard for global exchange.

As explained on pages 8 and 9 of the Appeal Brief, Kraslavsky et al already provide a well-known standard (e.g., a global standard) for exchanging messages and performing

electronic communication. Thus, as Kraslavsky et al already contain a global standard for exchanging messages, it would not have been obvious to modify Kraslavsky et al to utilize Internet e-mail to transfer messages globally between devices as this function is already available within Kraslavsky et al.

4. A reference cannot be modified to destroy its purpose.

As explained on pages 10-12 of the Appeal Brief, the Examiner is destroying two different essential features of Kraslavsky et al and therefore, the prior art is in effect teaching away from the modification to the prior art which is necessary to achieve the claimed invention. Details of why the essential features are being destroyed are set forth on pages 10-12 of the Appeal Brief and should be referenced.

II. Arguments With Respect to Group IV

Group IV includes Claims 18 and 44. These claims specifically recite the transmitting of a connection mode message when the status information is outside of normal parameters. The independent claims from which these claims depend further recite the transmitting of an Internet electronic mail message. Thus, the claims at issue require the system to have the capability to perform the transmitting of an Internet electronic mail message and also the transmitting of a connection mode message when the status information is outside of the normal operating parameters.

While the Applicant strongly believes that the rejection of the independent claims is improper, even if the rejection of the independent claims is maintained, using the combination of Kraslavsky et al and Cohen et al, the rejection of Group IV containing Claims

18 and 44 cannot be maintained. If the primary reference of Kraslavsky et al can be properly modified based on the teachings of Cohn et al (which the Applicant believes it cannot, as set forth in the Appeal Brief with respect to the arguments of Group I), the resulting system would transmit messages by electronic mail messages. As electronic mail messages are not connection mode messages, the system would not use a connection mode of communication. Thus, it is completely improper to find that the combination of Kraslavsky et al and Cohn et al provide both a teaching in which an Internet electronic mail message is transmitted, and also under specific circumstances which are recited in the claims, a connection mode message is transmitted.

In summary, the prior art simply would not provide any motivation to provide a system which operates in two different modes, as recited in the claimed combination of Group IV.

Therefore, the rejection of Group IV should be withdrawn.

Consequently, the reversal of each of the outstanding rejections is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Attorney of Record
Registration No. 25,599
James J. Kulbaski
Attorney
Registration No. 34,648

Crystal Square Five - Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202